



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 546,085	04 10 2000	Allan Bradley	P01433US1	3389

26271 7590 08 19 2002

FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
----------	--------------

1637

DATE MAILED: 08/19/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/546,085

Applicant(s)

BRADLEY ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-77 is/are pending in the application.
- 4a) Of the above claim(s) 42-62 and 65-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-41, 63 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' response to the office action and amendment (Paper No. 7) filed on May 8, 2002 has been entered.
2. The response to restriction requirement (Paper No. 7) filed on May 8, 2002 has been entered and considered.
3. The Information Disclosure Statement (Paper No. 8) filed on May 15, 2002 has been entered and considered.

Response to Arguments

3. Applicant's response to the office action (Paper No.7) is fully considered and deemed persuasive.
4. The rejection made under 35 U.S.C. 112 second paragraph in the previous office action is withdrawn herein in view of the applicants' amendment (Paper No.7).
5. The rejection made under 35 U.S.C. 102(b) in the previous office action is withdrawn herein in view of the applicants' amendment (Paper No.7).

New Grounds of Rejection necessitated by Amendment

6. Applicant's election without traverse of Group I (claims 8-41, 63-64) in Paper No. 7 is acknowledged. Claims 42-62, and 65 are withdrawn from further consideration. New claims 66-77 read on non-elected claims and hence are withdrawn from further consideration.
7. Claims 8-41 and 63-64 in Group I are considered for examination in this office action.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Art Unit: 1637

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8, 13-17, 22-25, 27, 31-34, 37, 39-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-10, 18-20, 25-28, and 33-34 of U.S. Patent No. 6,048,695 ('695). Although the conflicting claims are not identical, they are not patentably distinct from each other because the biological molecule of the instant claims encompasses nucleic acids as claimed in the patented claims ('695). Biological molecule comprises a nucleic acid (DNA or RNA), a protein, or a peptide, lipid or a polysaccharide molecule. Further, the compound used to modify a nucleic acid of the patented claims has the said formula as claimed in the instant claims. The instant claims differ from patented claims only in reciting 'biological molecule' in place of 'nucleic acid' which is an obvious variation of the term nucleic acid. Further the high-density microarray disclosed in the patented claims is recited as microarray in the instant claims. Therefore, the instant claims are not patentably distinct and hence are rejected under obviousness-type double patenting.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

Art Unit: 1637

filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 8-25, and 27-32 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 8-11, 18, 20-28, and 54 of prior U.S. Patent No. 09/ 853,343. This is a double patenting rejection.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

a. Claims 8-24, 35-38, and 63-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claims are indefinite and unclear for reciting 'a moiety chemically suitable...'. It is unclear what moiety the instant claims refer for. Is it an enzyme based or a ligand based moiety. Amendment of claims to properly recite the phrase would obviate this rejection.

b. Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claims are indefinite or unclear because it is not clear whether the claims are drawn to a product or a process. Amendment to properly recite the invention would obviate this rejection.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1637

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

a. Claims 8-9, 12-18, 21, 23-24, and 63-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Krinski et al. (USPN. 4,713, 116).

Krinski et al. teach a modified biological molecule (protein) wherein Krinski et al. teach that the modified biological molecule comprises a biological molecule covalently bound to a compound having formula R_1-X-R_2 and the compound could be glycodoxypyriltrimethoxy-silane (see column 3, lines 8-10, column 4, lines 31-41). Krinski et al. also teaches that the modified biological molecule could be a protein material, a peptide or a polypeptide (see column 4, lines 31-53); the alkoxysilane could be a propyl trimethoxy silane (see column 4, lines 31-41); and could include addition of amino groups to the modified biological molecule (see column 4, lines 54-67). Thus, the disclosure of Krinski et al. meets the limitations in the instant claims.

(b) Claims 25, and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Plueddemann (USPN. 4,231,910).

Plueddemann teaches a modified biological molecules (primer compositions) on a solid support wherein Plueddemann discloses a solid support and immobilized modified biological

molecules (see column 3, lines 22-29). Plueddemann also teaches that (i) the solid support comprises glass, quartz, aluminum, titanium, and metal oxides (see column 3, lines 22-29); and (ii) solid support could also comprise polyesters, polycarbonates, polyethelene terephthalate, and nylon (column 3, lines 30-54). Thus the disclosure of Plueddemann meets the limitations in the instant claims.

(c) Claims 25-29, and 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Beattie (USPN. 6,426,183).

Beattie teaches microarrays comprising modified biological molecules wherein Beattie discloses that the microarray comprises (i) a solid support and (ii) a modified biological molecule (oligonucleotides) immobilized to said solid support (see column 3, lines 1-4). Beattie also disclose that (i) the solid support comprises silane containing substrates which include hydroxyl groups (see column 4, lines 46-54, column 3, lines 5-9); (ii) solid support comprises glass, quartz, metal oxides (see column 4, lines 13-36); and (iii) biological molecules on solid support are immobilized in discrete spots at a suitable distance from one another, typically from about 0.01 to 10mm of one another (see column 12, lines 25-31). Thus the disclosure of Beattie meets the limitations in the instant claims.

No claims are allowable.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.


Art Unit: 1637

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Suryaprabha Chunduru

August 15, 2002


JEFFREY FREDMAN
PRIMARY EXAMINER